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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,436	10/31/2003	Shinichi Ito	04329.2437-02	7730

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EXAMINER
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BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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# **Advisory Action Before the Filing of an Appeal Brief**

Application No. 10/697,436		Applicant(s) ITO, SHINICHI	
Examiner Katherine A. Bareford		Art Unit 1762	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 14 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## **NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

## **AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 15-17.

Claim(s) withdrawn from consideration: 11-13 and 18-24.

## **AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

## **REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because: after the after final amendment, the following rejections remain outstanding (1) the double patenting rejection of claims 15-17 as addressed at paragraphs 6-8 of the Final Rejection. As applicant provided no arguments against the double patenting rejection, the rejection is maintained. (2) claims 15-17 remain rejected under 35 USC 112, second paragraph, specifically because, as addressed at pages 4-5 of the Final Rejection, with regard to lines 20-24 (now lines 10-16), "this section describes distance relationships, which as described in the specification and at Figures 16 and 23, appear to require that all of the application of coating occurs on the substrate, with an edge area of the substrate that is not coated. However, from the wording of the claims, it appears that the dropping point, etc. could occur outside of the substrate, so that during the coating the entire substrate is covered. It is unclear how the invention would work if this is the case.", In regard to this portion of the rejection, applicant argues that the claim's recitation does not suggest that the dropping point, etc. could occur outside of the substrate, so that the entire substrate is covered. The Examiner has reviewed this argument, however, the rejection is maintained. claim 15, at lines 1-5 describes a process for dropping a liquid to be spread on a substrate, and then at lines 6-9 describes the movement direction of the nozzle, and then at lines 10-16 describes the positioning of the various distances relative to one another. For example, the distance between the dropping start position and and edge of the substrate closest to the dropping start position is relatively larger than a distance between a dropping end position and an edge of the substrate closest to the dropping end position. However, none of these descriptions of "dropping start position", "dropping end position", etc. require that the start or end position be such that at the start or end position coating is deposited onto the substrate itself. For example, the dropping start position could be 2 cm outside of the substrate (giving a distance between the start position and closest edge of the substrate of 2 cm) and the end position could be 1 cm outside the substrate (giving a distance between the end position and closest edge of the substrate of 1 cm). This would fall within the wording of the claim, but as addressed above, if the starting points and ending points are not within the bounds of the substrate, it is unclear how the invention would work..

  
**KATHERINE BAREFORD**  
**PRIMARY EXAMINER**